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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,472	01/15/2004	Kazuki Hayashibara	010482.53148US	4145
23911 7590 01/02/2008 CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			EXAMINER SHIBRU, HELEN	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 01/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/757,472

Applicant(s)

HAYASHIBARA ET AL.

Examiner

HELEN SHIBRU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, and 4-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendments, filed 11/06/2007, have been entered and made of record. Claims 2-3 are cancelled, claim 5 is added and therefore claims 1, and 4-5 are now pending.

Response to Arguments

2. Applicant's arguments, filed 11/06/2007, with respect to the rejection(s) of claim(s) 1, 4 and 5 have been fully considered but are moot in view of the new ground(s) of rejection.

The new grounds of rejection provided herein is based on an updated inventor search, wherein the examiner of record has deemed located related other relevant/related applications associated with this application, therefore, the examiner has rejected these claims under Provisional Obvious Double Patenting below.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either

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is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 and 4-5 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over ^{claims 1-3} ~~claim 1~~ of copending

Application No. 11/330342. Although the conflicting claims are not identical, they are not patentably distinct from each other. See below.

Regarding claim 1, the copending Application claim 1 recites An optical disc reproduction apparatus comprising: an optical pickup that reads compressed data of video and audio recorded on an optical disc; storing means that stores a table containing identification information for identifying type of the compressed data read by the optical pickup; a demultiplexer that sorts the compressed data read by the optical pickup according to the type of the compressed data based on the identification information stored in the storing means; video reproducing means that reproduces video data based on the compressed data of video sorted out by the demultiplexer; audio reproducing means that reproduces audio data based on the compressed data of audio sorted out by the demultiplexer; and a controller that controls the optical pickup, the storing means, the video reproducing means, and the audio reproducing means, wherein the identification information stored in the storing means contains audio identification information for identifying type of the audio data, wherein the audio reproducing means has various audio decoders for reproducing compressed data of various types of audio read by the optical pickup, is configured to compare audio identification information contained in the compressed data of audio read by the optical pickup with the audio identification

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information stored in the table in order to identify type of the compressed data of audio read by the optical pickup and select, according to the identified type of the compressed data, a corresponding audio decoder from among the various audio decoders, and is furnished with no capability of outputting DTS audio on an analog basis but a capability of outputting DTS audio on a digital basis, wherein the controller includes: audio number checking means that checks whether an audio number of DTS audio on an optical disc is greater or smaller than an audio number of other audio; first reproduction starting means that, if the audio number checking means finds the audio number of the DTS audio to be greater than the audio number of the other audio, starts reproduction of the audio other than the DTS audio; output setting checking means that, if the audio number checking means finds the audio number of the DTS audio to be smaller than the audio number of the other audio, checks whether, during setup, DTS digital output is set for digital output or turned off; second reproduction starting means that, if the output setting checking means finds the DTS digital output to be set for digital output in a form of a bit stream, starts reproduction of the DTS audio assigned an audio number "1"; and third reproduction starting means that, if the output setting checking means finds the DTS digital output to be turned off, starts reproduction of audio, other than the DTS audio, assigned a smallest audio number among audio numbers "2" and greater.

Therefore claim 1 is encompassed by the claim 1 of copending application 11/330342, because '342 is deemed narrower for reciting an additional limitations, wherein claim 1 of the present application does not recite these additional limitation, therefore the scope is different, but to be reject-able under, obviousness-type double patenting for being broader.

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Regarding claim 4, the copending application fails to particularly recite the audio identification information comprises an entirety of a stream identifier and a part of a substream identifier.

The examiner takes Official Notice that an audio identification information comprising an entirety of a stream identifier and a part of a substream identifier is well known in the art and therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further recite an audio identification information comprises an entirety of a stream identifier and a part of a substream identifier in order to separate data.

Regarding claim 5, the copending application claims 1-3 recite An optical disc reproduction apparatus comprising: an optical pickup that reads compressed data of video and audio recorded on an optical disc; storing means that stores a table containing identification information for identifying type of the compressed data read by the optical pickup; a demultiplexer that sorts the compressed data read by the optical pickup according to the type of the compressed data based on the identification information stored in the storing means; video reproducing means that reproduces video data based on the compressed data of video sorted out by the demultiplexer; audio reproducing means that reproduces audio data based on the compressed data of audio sorted out by the demultiplexer; and a controller that controls the optical pickup, the storing means, the video reproducing means, and the audio reproducing means, wherein the identification information stored in the storing means contains audio identification information for identifying type of the audio data, wherein the audio reproducing means has various audio decoders for reproducing compressed data of various types of audio read by the

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optical pickup, is configured to compare audio identification information contained in the compressed data of audio read by the optical pickup with the audio identification information stored in the table in order to identify type of the compressed data of audio read by the optical pickup and select, according to the identified type of the compressed data, a corresponding audio decoder from among the various audio decoders, and is furnished with no capability of outputting DTS audio on an analog basis but a capability of outputting DTS audio on a digital basis, wherein the controller includes: audio number checking means that checks whether an audio number of DTS audio on an optical disc is greater or smaller than an audio number of other audio; first reproduction starting means that, if the audio number checking means finds the audio number of the DTS audio to be greater than the audio number of the other audio, starts reproduction of the audio other than the DTS audio; output setting checking means that, if the audio number checking means finds the audio number of the DTS audio to be smaller than the audio number of the other audio, checks whether, during setup, DTS digital output is set for digital output or turned off; second reproduction starting means that, if the output setting checking means finds the DTS digital output to be set for digital output in a form of a bit stream, starts reproduction of the DTS audio assigned an audio number "1"; and third reproduction starting means that, if the output setting checking means finds the DTS digital output to be turned off, starts reproduction of audio, other than the DTS audio, assigned a smallest audio number among audio numbers "2" and greater; the optical disc reproducing means reproducing information recorded on an optical disc; and a controller that when DTS digital output is set for digital output during setup and in addition DTS audio is assigned an audio number "1", selects and starts to reproduce the DTS audio and

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when DTS digital output is turned off during setup, selects and starts to reproduce audio assigned a smallest audio number other than the DTS audio; the controller includes: audio number checking means that checks whether an audio number of DTS audio on an optical disc is greater or smaller than an audio number of other audio; first reproduction starting means that, if the audio number checking means finds the audio number of the DTS audio to be greater than the audio number of the other audio, starts reproduction of the audio other than the DTS audio; output setting checking means that, if the audio number checking means finds the audio number of the DTS audio to be smaller than the audio number of the other audio, checks whether, during setup, DTS digital output is set for digital output or turned off; second reproduction starting means that, if the output setting checking means finds the DTS digital output to be set for digital output in a form of a bit stream, starts reproduction of the DTS audio assigned an audio number "1"; and third reproduction starting means that, if the output setting checking means finds the DTS digital output to be turned off, starts reproduction of audio, other than the DTS audio, assigned a smallest audio number among audio numbers "2" and greater.

Therefore claim 5 is encompassed by the claims 1-3 of copending application 11/330342, because '342 is deemed narrower for reciting an additional limitations, wherein claim 5 of the present application does not recite these additional limitation, therefore the scope is different, but to be reject-able under, obviousness-type double patenting for being broader.

This is a provisional obviousness-type double patenting rejection.

Conclusion

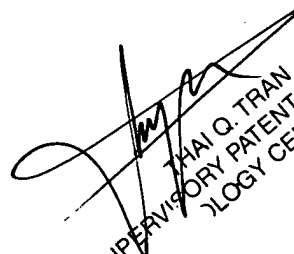
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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru
December 11, 2007


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SUPERVISORY PATENT EXAMINER
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